

REMARKS

Reconsideration of the present application is respectfully requested.

Claims 1-22 have been rejected under 35 U.S.C. 103(a) as being obvious in view of DeLorme. This rejection is respectfully traversed.

Claims 1-10 are canceled herein without prejudice or disclaimer.

Claims 11 and 14 are directed to a vehicle navigation system such as the system described in connection with the third embodiment of the present invention on pages 19 and 20 of the present invention. Claim 11 has been amended to further recite:

[[a]] data storage means for storing data on categories of points of interest and for storing data on supplemental items regarding facilities and services that are available at the points of interest and that are in a manner that enables the data on supplemental items to be searchable regardless of the categories of points of interest[[,]]; and

[[the]] control means ~~performs~~ for performing a search for a point of interest that provides a supplemental item specified by an input from a user based on the data stored in the data storage means.

Claim 14 has been amended in a similar manner. As previously discussed in the Amendment filed on August 24, 2005, the claimed data storage means is capable of storing supplemental items regarding facilities and services (such as restrooms) in a manner that enables the data on supplemental items to be searchable regardless of POI categories (such as convenience stores). For example, a convenience store is primarily designed for providing retail sales and not for providing restroom service. However, in the vehicle navigation system of the present invention, the convenience store POI is stored so as to be correlated with a supplemental item, i.e., restroom service. As a result, a user can readily determine where (at which point of interest) he/she can find a supplemental item by inputting the desired supplemental item,

regardless of the category into which the POI offering the restroom service is classified. (See, for example, FIG. 12, page 19, lines 3-8 and page 20, lines 12-17.)

Unlike the vehicle navigation system recited in claims 11 and 14, DeLorme fails to teach or suggest a navigation system that stores data on categories of points of interest and on supplemental items regarding facilities and services in a manner that enables the data on supplemental items to be searchable regardless of the categories of points of interest.

The Examiner states in numbered paragraph 2 of the Final Rejection that “the rejection mailed on 3/24/2005 is maintained (please note that the amended clauses for independent claims 11 and 14 indicate that POIs were already known as ‘searchable information’ without inputting POIs’ category...) because they are claimed that ‘that [sic] are searchable regardless of the categories of points of interest.’ Cited reference of DeLorme et al. also provides supplemental information of POI...”.

Based on the Examiner’s above paraphrasing of claims 11 and 14, it appears that he believes the claims recite that points of interest (POIs) are searchable regardless of the POIs’ respective categories. This is an incorrect interpretation of the claims. Specifically, claims 11 and 14 recite *inter alia* a data storage means for storing data on supplemental items in a manner that enables the data on supplemental items to be searchable regardless of the POI categories. In other words, a user can search for supplemental items, such as the location of a restroom, independently from POI categories, such as banks or gas stations. See discussion of the third embodiment on page 20, lines 12-17 in the present application.

DeLorme does not teach or suggest data storage means or control means that enables a user to search for the location of a restroom regardless of whether the restroom is located in a bank or a gas station. Figs. 1L and 1M, col. 17, lines 17-33 and col. 19, lines 26-44 of DeLorme

describe supplemental items that may be displayed with POIs such as hotels or restaurants. However, DeLorme provides no disclosure regarding the storage or searching of supplemental items independently from POIs.

Further, the Examiner should note that claims 11 and 14 have been amended so that the recitation of both “data storage means” and “control means” clearly fall within the definition of means-plus-function type functional language as provided by 35 USC 112, sixth paragraph, which states:

An element in a claim...may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The Examiner apparently asserts in numbered paragraph 3 on page 3 of the Final Rejection that claims 11 and 14 are directed to a system with physical components and that supplemental items, such as campground information shown in Fig. 1M of DeLorme, are merely non-functional descriptive material that does not change the structural configuration of the claimed system. However, the “data storage means” and “control means” recited in independent claims 11 and 14 are recited in means-plus-function format. The way in which the data storage means stores the data, and the way in which the control means performs a search, are not “non-functional descriptive material” as asserted by the Examiner, but rather are functional limitations.

In view of the Examiner’s above noted remarks, and as in the Office Action mailed on August 24, 2004, the Examiner has failed to fully consider the issue of how much weight to afford the functional portions of the means-plus-function limitations in view of the case law provided for just that purpose in MPEP 2181-2186 (see reference to these sections at the beginning of MPEP 2114). The Examiner should note that there is ample precedent to establish

that functional limitations should be afforded patentable weight. (See, e.g., *In re Land*, 368 F.2d 866, 151 USPQ 621 (C.C.P.A. 1966).)

In addition, pursuant to the examination guidelines provided in, for example, MPEP 2182-2183, the application of a prior art reference to a means- or step-plus-function limitation requires that a prior art element perform the identical function specified in the claim. The Examiner must show that the prior art structure or step is the same as or equivalent to the structure, material or acts described in the specification and identified as corresponding to the claimed means- or step-plus-function only if the prior art reference teaches identity of function to that specified in the claim. (Emphasis added; see MPEP 2182, second complete paragraph.).

In examining a means- or step-plus-function limitation, the Examiner should provide an explanation as to why the prior art element is an equivalent if the prior art element (A) performs the function specified in the claim, (B) is not excluded by any explicit definition provided in the specification for an equivalent, and (C) is an equivalent of the means- (or step-) plus-function limitation. (Emphasis added; see MPEP 2183.)

In view of the above examination guidelines set forth in the MPEP, the Examiner has used the incorrect standard for examining the means-plus-function terminology in claims 11 and 14, and has therefore failed to fully consider the issue of how much weight to afford the functional portions of the means-plus-function limitations (e.g., storing data on supplemental items in a manner that enables the data on supplemental items to be searchable regardless of the POI categories). As a result, he has failed to show how the DeLorme system performs the same function as the recited “data storage means” or the “control means.” Even assuming *arguendo* that the Examiner used the correct standard, DeLorme clearly does not disclose, teach or suggest the functions of the recited “data storage means” or “control means.”

As the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claims 11 and 14, it is respectfully requested that the Examiner's rejection of claims 11 and 14, as well as claims 12, 13 and 15-22 dependent thereon, be withdrawn.

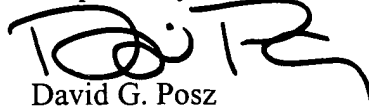
Further, regarding dependent claims 20-22, these claims specifically recite the types of supplemental items that are stored by the storage means in the claimed manner. DeLorme fails to teach or suggest storage of such items in the claimed manner (see last paragraph on page 7 of the previously filed Amendment). Therefore, claims 20-22 further distinguish the presently claimed invention over DeLorme.

The Examiner should note that new claim 23 has been added. Claim 23 recites the navigation system of the present invention in a manner similar to claim 11 albeit in non-means-plus-function format. Support for claim 23 can be found throughout the specification and drawings. See, for example, discussion of the third embodiment on pages 19-20 of the present application.

In view of the foregoing, the Applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due, to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Posz', written over the printed name.

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